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**OFFICIAL**

DATE: July 12, 2004

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In re the Application of:

William Hsiao-Yu Ku )

Serial No. 09/734,805 )

Filed: 12/11/2000 )

Docket: AUS9-2000-0768-US1 )

For: "Search Facilities for Local and )

Remote Interface Repositories" )

Group: 2175

Examiner: Samuel G. Rimell

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**OFFICIAL****REPLY BRIEF*****Request for Oral Hearing***

Applicant hereby requests an oral hearing on the above Appeal. The fee required by 37 CFR §1.17(d) for this request is enclosed.

***Reply to Examiner's Answer***

As provided by 37 CFR §1.193(b)(1), applicant submits the following comments in reply to the Examiner's Answer in the above Appeal.

Summary of the Invention. Applicant request's the Board to consider the Applicant's "Summary of the Invention" as provided in the Appeal Brief, as well as the Summary of the Invention as provided in the Applicant's disclosure. Applicant's brief summary of CORBA was necessitated by the grounds of rejection being appealed, wherein our claimed subject matter relates to CORBA. As such, a concise summary of CORBA was provided in order to frame the nature of the claimed subject matter.

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Issues. Examiner has stated that Applicant has not properly identified the issues for review by the Board, and that Applicant's statement is argumentative. MPEP 1206 states:

... While the statement of the issues must be concise, it should not be so concise as to omit the basis of each issue. ...

In our statement of the issues, we indicated that the Examiner has held Hogan's TCP/IP protocol is the same as our recited CORBA ORB protocol. This is the basis of the issue, which is properly set forth in this section of the Appeal Brief. Applicant requests consideration of this section of the Appeal Brief.

Grounds of Rejection. In the Examiner's Answer, the examiner has stated:

The repositories are a series of internetworked databases that contain programming objects (col. 8, lines 55 - 58). The repositories are accessible through the TCP/P protocol (col. 11, lines 9 - 10), which is readable an ORB since it is a protocol that permits access to programming objects through a brokering interface (FIG. 4).

In this statement, the examiner has agreed with our position that Hogan does not *explicitly teach* our claimed step of "performing at least one search of at least one IR using said ORB protocol" (Claims 1 and 14) or "an IR searcher for searching one or more ORB interface repositories" (Claim 27). Please note that Hogan's Figure 4 contains no annotation "brokering interface", and that the entirety of Hogan's disclosure is silent as to "brokering" in any manner.

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It is unclear from the examiner's statement, however, whether examiner is reading the prior art onto the claim, which would be improper examining procedure.

Possibly, the examiner is stating that Hogan's TCP/IP-accessible databases are *functionally equivalent* to our searching of an Object Request Broker, which would be an improper basis for a 35 USC §102(b) rejection of a claim which is not in step-plus-function or means-plus-function format.

Another possibility is that examiner is arguing that Hogan's TCP/IP-accessible object databases *inherently teach* an Object Request Broker. For a rejection under 35 U.S.C. §102 based upon inherent teaching, the examiner must provide *extrinsic* evidence that such teaching would be "so recognized by persons of ordinary skill":

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. ... This modest flexibility in the rule that 'anticipation' requires that every element of the claims appear in a single reference accommodates situations where the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges."

*Continental Can Co. U.S.A. v. Monsanto Co.*, 20 USPQ2d at 1749 (Fed. Cir.)

Examiner has not provided any such extrinsic evidence that a ordinarily skilled person in this art would read Hogan's TCP/IP-accessible databases as an ORB searching operation or use of a brokering interface.

To the contrary, Applicant traversed (and maintains traversal) that examiner has properly established a *prima facie* case of anticipation under 35 U.S.C. §102, wherein differences between a CORBA Object Request Broker and TCP/IP, and differences between a database of program objects (Hogan) and a CORBA Interface Repository (IR) have been well established during prosecution by the applicant through the submission of *extrinsic evidence* (e.g. industry definitions and tutorials) regarding CORBA and TCP/IP.

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This extrinsic evidence clearly indicates that an ordinarily skilled technologist would not read "TCP/IP" as "CORBA" or "ORB". Please refer specifically to applicant's submission of this extrinsic evidence taken from WhatIs.com (a widely used online computing and communications information database), and from "Instant CORBA" by Orfali (a reference book published by Wiley and Sons), in a reply to an Office Action dated May 23, 2003.

The Federal Circuit has stated that anticipation under 35 U.S.C. §102 requires there to be no differences between the claimed invention and the cited art as would be viewed from one of ordinary skill in the art:

"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention."  
*Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)

Based upon the applicant-supplied extrinsic evidence, and upon the lack of evidence supplied by the examiner to the contrary, TCP/IP and CORBA ORB are different from each other. For this reason, the rejections of our claims over Hogan under 35 U.S.C. §102 should be reversed.

With specific reference to examiner's reply regarding Claim 6, examiner has stated that Hogan's queries for program objects have the "same exact purpose" as our CORBA queries (pg. 4 of Examiner's Answer), and therefore Hogan's disclosure anticipates our limitation of performing a CORBA query in our Claim 6. There is no basis in law or examination procedure for a "same exact purpose" rejection such as this, especially in view of the fact that this element of Claim 6 is not set forth in means-plus-function or step-plus-function format. Additionally, it has been established in the prosecution record that the "purpose" of Hogan's query is to find an object of program source code to check out, download and compile into a new program, wherein the object of a CORBA query is to remotely invoke a remotely-executed program object (e.g. not to download it or incorporate it into another program).

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Response to [Applicant's] Argument. In the Examiner's Answer, the examiner has stated that the present claims "do not invoke CORBA at all", and thus applicant's arguments that CORBA and TCP/IP are dissimilar are "essentially moot" in that the examiner does not find that "CORBA is ever even being called".

CORBA, however, is not a "callable" program such as a subroutine, but instead is an architecture of components which are already running (typically) when a client program requests the functionality of another program object. When the client program needs such services from another program object, it posts a request to find an interface to suitable program objects, which is handled by the CORBA Object Request Broker (ORB) component. As such, the requesting client program does not have to "call" or "invoke" CORBA, but instead must only transmit a request to the already-running ORB component of the CORBA architecture.

This is well known in the art by those ordinarily skilled in the art. Additionally, an ORB and an IR are components of CORBA, not of TCP/IP, as explained to the Examiner in the previous Office Action replies. There is no indication in the extrinsic evidence provided by the applicant, and no extrinsic evidence presented by the examiner at all, to indicate that any ordinarily skilled persons in the art would interpret that an ORB or IR was somehow part of TCP/IP, or vice versa.

Thus, examiner's statement regarding non-recitation of CORBA or ORB is in direct contradiction to the contents of our claims as follows, especially claim 6:

- Claim 1: "performing at least one search of at least one IR using said ORB protocol"
- Claim 6: "performing a Common Object Request Broker Architecture (CORBA) Interface Repository query"
- Claim 14: "performing at least one search of at least one IR using said ORB protocol"
- Claim 27: "an IR searcher for searching one or more ORB interface repositories"

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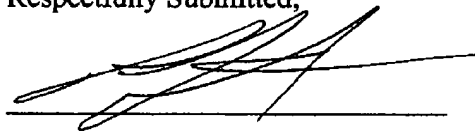
The examiner has not properly shown how or if an "ORB" or "IR" could be part of TCP/IP, and has not properly shown that databases of checked-in source code must be the same as an Interface Repository (IR).

***Conclusion***

We have responded to points of the Examiner's Answer for which we believe need additional rebuttal. We maintain our arguments and traversals as set forth in our Appeal Brief, and respectfully do not concede to any points set forth in the Examiner's Answer.

For the foregoing reasons, it is submitted that the examiner's rejections of Claims 1 - 39 were erroneous, and reversal of these decisions is respectfully requested.

Respectfully Submitted,



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